



28 JUN 2006

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In re Application of JOUNG et al :
U.S. Application No.: 10/532,258 :
PCT Application No.: PCT/US03/34010 :
Int. Filing Date: 23 October 2003 :
Priority Date Claimed: 23 October 2002 :
Attorney Docket No.: 6203(51588) :
For: CONTEXT SENSITIVE PARALLEL :
OPTIMIZATION OF ZINC FINGER DNA :
BINDING DOMAINS :
DECISION

This is in response to applicant's "Petition Under 37 C.F.R. §1.47(a)" filed 18 May 2006.

BACKGROUND

On 23 October 2003, applicant filed international application PCT/US03/34010, which claimed priority of an earlier United States application filed 23 October 2002. The thirty-month period for paying the basic national fee in the United States expired on 23 April 2005.

On 21 April 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 15 December 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 18 May 2006, applicant filed the present petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be

reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, the declaration submitted with the petition is improper. Specifically, pages 1-3 appear to be original sheets while page 4 appears to have been transmitted by facsimile. Thus, the declaration is a composite of two different documents. It is not acceptable to combine pages of different documents into a single declaration.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventor Carl Pabo refuses to sign the application papers. However, petitioner has not adequately demonstrated that a bona fide attempt was made to present a copy of the application papers to Dr. Pabo for signature. Although the electronic mail message from Dr. Pabo suggests that he was possibly in possession of the application papers, there is no affirmative statement that the application papers were ever presented to Dr. Pabo. Furthermore, although the electronic mail message is evidence of Dr. Pabo's refusal to sign, petitioner has not provided an affidavit specifying the circumstances of the purported refusal from Sandra Fay-Richard, i.e. the person to whom the purported refusal was made. Thus, it would not be reasonable to conclude at the present time that Dr. Pabo refuses to join in the application.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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